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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
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2165

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/075,283	Applicant(s) IWAYAMA ET AL.	
	Examiner NEVEEN ABEL JALIL	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. In response to Applicant's amendment filed on July 9, 2008, claims 11-17 remain pending in the application.
2. Applicant's response and discussion during the in-person interview on July 31, 2008 has overcome the previously presented rejections under 112, first and second paragraph. Although the referenced page in the remarks does begin to explain the "weighting calculations", it also goes on to explain two different calculations constructing the word summary which appear to be missing from the claim language See Specification page 7, lines 1-10. Therefore, the prior interpretation made of record by the Non-Final OA (page 3) with regards to "the second search of the second database" is still valid.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/442,147.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 11-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Newly added claimed limitations of "*calculating a second weight of each term, which reflects the importance of the term, of each document derived from the second document database by the second search;*

finding out a relevance of each document derived from the second document database by calculating an overall weight on both said weighted term it and the calculated second weights for each document with respect to terms common in both"

Do not correspond to Applicant's specification paragraphs 0023-0024 published version since the paragraphs noted specifically state the second weight is part of the summary making (i.e. occurring at the first database). The second database is only presented with the summary and is not included in any weighting calculations.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishioka et al. (U.S. Patent No. 6,457,004 B1) as best understood under the 112, second rejection above.

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

As to claim 11, Nishioka et al. discloses a computer implemented service for searching documents wherein servers comprising document databases and programs to manipulate said databases are dispersed over a network and a client connected to said servers performs a document search, said service providing a document search method comprising the steps of:

making a first search input of a set of keywords, fragments of a document or any desired set of documents to a first document database (See column 11, lines 1-6);

conducting a first search of said first document database based in said first search input (See Figure 5, 3441MR, shows keyword search, also see column 10, lines 60-67);

retrieving at least one document as a result of said first search (See column 9, lines 8-16);

inputting said at least one retrieved document to said first document database (See column 9, lines 8-16);

making a weighted term list, whereby each term is given a weight, from said inputted documents, the weight of each term reflecting the importance of the term in the first document database (See column 9, lines 30-46),

performing a second search of a second document database based on said weighted term list (See column 24, lines 63-67, and see column 25, lines 1-30);

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wherein said weighted term list is used as a second search input that performs said search of said second document database (See column 24, lines 63-67, and see column 25, lines 1-30);

calculating a second weight of each term, which reflects the importance of the term, of each document derived from the second document database by the second search (See column 15, lines 1-50, it is inherent if one weight can be calculated for a term then a second can also be ascribed);

finding out a relevance of each document derived from the second document database by calculating an overall weight on both said weighted term it and the calculated second weights for each document with respect to terms common in both (See column 31, lines 41-64); and

wherein an interface is provided in which any of said documents retrieved by said first said search is selected or deselected, and a set of said at least one document that is selected via said interface is used in preparing the second search input that searches said second document database (See column 14, lines 33-61); and

displaying result of said search on a display unit (See Figure 4, shows all data capable of being displayed on display unit).

As to claim 12, Nishioka et al. discloses wherein a summary containing only topic words in said at least one document is used to perform the second search (See column 12, lines 1-67).

As to claims 13, and 17, Nishioka et al. discloses wherein the client transmits said at least one document to a server where said first document database is stored, receives a summary comprising only topic words related to said at least one document which is sent, sends the second

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search input corresponding to said summary reflecting a user's evaluation of the summary to the server where said second document database is stored, and receives a search result from the search of said second document database (See column 11, lines 31-55).

Independent claim 14 is directed to similar limitations as claim 11 above and thus rejected under the same rational, with the only difference of stating:

wherein a summary containing only topic words in said at least one document is used to perform the second search (See corresponding rejection for claim 12 above).

Independent claim 15 is directed to similar limitations as claim 11 above and thus rejected under the same rational, with the only difference of stating:

wherein the client transmits said at least one document to a server where said first document database is stored, receives a summary comprising only topic words related to said at least one document which is sent, sends the second search input corresponding to said summary reflecting a user's evaluation of the summary to the server where said second document database is stored, and receives a search result from the search of said second document database (See corresponding rejection for claim 13 above).

As to claim 16, Nishioka et al. discloses wherein said server where said first document database is stored produces a summary from topic words relevancy to said at least one document sent by the client and transmits the summary to the client, and further searches and transmits to the client a set of documents having a high relevance to said second search input sent by the

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client (See column 7, lines 25-35, and see column 11, lines 40-51, wherein “having a high relevance to said second search” reads on “documents” retrieval as related concepts to the expanded search result, “associative search”).

Alternatively, the claims are rejected under:

8. Claims 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Barr et al. (U.S. Patent No. 5,873,076)- as best understood under the 112, second rejection above.

As to claim 11, Barr et al. discloses a computer implemented service for searching documents wherein servers comprising document databases and programs to manipulate said databases are dispersed over a network and a client connected to said servers performs a document search (See Figure 3, DB 117, DB 118, wherein each document database includes a server associated with it), said service providing a document search method comprising the steps of:

making a first search input of a set of keywords, fragments of a document or any desired set of documents to a first document database (See Figure 2, 202);

conducting a first search of said first document database based in said first search input (See column 4, lines 43-45);

retrieving at least one document as a result of said first search (See column 4, lines 45-48);

inputting said at least one retrieved document to said first document database (See column 3, lines 20-26, and see column 11, lines 16-20);

making a weighted term list, whereby each term is given a weight (See Figure 5A), from said input of said at least one retrieved document to said first document database, the weight of each term reflecting the importance of the term in the first document database (See column 4, lines 19-23, and column 12, lines 54-65, shows parsing the document to form an index then using the index once a query is performed),

automatically performing a second search of a second document database based on said weighted term list from said first document database (See Figure 4A, wherein “advanced searching” bottom is shows 349a, also see column 2, lines 29-34);

wherein said weighted term list is used as a second search input that performs said search of said second document database (See column 3, lines 38-42), and

calculating a second weight of each term, which reflects the importance of the term, of each document derived from the second document database by the second search (See column 32, lines 28-52, it is inherent if one weight can be calculated for a term then a second can also be ascribed);

finding out a relevance of each document derived from the second document database by calculating an overall weight on both said weighted term it and the calculated second weights for each document with respect to terms common in both (See column 4, lines 19-33, wherein the search result retrieves both DB data wherein the search is expanded); and

wherein an interface is provided in which any of said at least one document input to said first document database is selected or deselected, and a set of said at least one document that is selected via said interface is used in preparing the second search input that searches said second document database (See column 15, lines 1-5, and see Figure 4, 350); and

displaying result of said search on a display unit (See column 14, lines 15-25).

As to claim 12, Barr et al. discloses wherein a summary containing only topic words in said at least one document is used to perform the second search (See column 9, lines 9-21, and see column 10, lines 5-15).

As to claims 13, and 17, Barr et al. discloses wherein the client transmits said at least one document to a server where said first document database is stored, receives a summary comprising only topic words related to said at least one document which is sent, sends the second search input corresponding to said summary reflecting a user's evaluation of the summary to the server where said second document database is stored, and receives a search result from the search of said second document database (See column 36, lines 38-52, wherein "user's evaluation" is read on "user feedback").

Independent claim 14 is directed to similar limitations as claim 11 above and thus rejected under the same rational, with the only difference of stating:

wherein a summary containing only topic words in said at least one document is used to perform the second search (See corresponding rejection for claim 12 above).

Independent claim 15 is directed to similar limitations as claim 11 above and thus rejected under the same rational, with the only difference of stating:

wherein the client transmits said at least one document to a server where said first document database is stored, receives a summary comprising only topic words related to said at least one document which is sent, sends the second search input corresponding to said summary reflecting a user's evaluation of the summary to the server where said second document database is stored, and receives a search result from the search of said second document database (See corresponding rejection for claim 13 above).

As to claim 16, Barr et al. discloses wherein said server where said first document database is stored produces a summary from topic words relevancy to said at least one document sent by the client and transmits the summary to the client, and further searches and transmits to the client a set of documents having a high relevance to said second search input sent by the client (See column 3, lines 38-54).

Response to Arguments

9. Applicant's arguments filed on July 9, 2008 have been fully considered but they are not persuasive.

In response to Applicant's argument that "the second search of Nishioka is conducted to refine or deepen the first search result, such as by searching on the same database, but not to broaden the scope of the search window. In other words, Nishioka does not teach the now-claimed second search of a second document database using a weighted term list derived from the results of the first search" is respectfully noted but not deemed to be persuasive.

Nishioka in Figure 6, top left portion, shows the ability to select from multiple databases, and in the same figure, bottom portion, Nishioka also shows button labeled “Expand” whereby the marked topic words produced by the search results of the current database can be used as an input either for result expansion or as an input for another database to retrieve more results.

While Nishioka in column 31, lines 41-67, and column 34, lines 25-45 teaches “associative search” using selected topic words produced by an original search can be preformed on either the same database or on another selected by user in the user's interface.

This is no different than what is disclosed in Applicant's specification paragraphs 0033-0035 (published version) wherein the new search is nothing more than the application of the result summary (indexed keywords) to a different database in hopes to acquire refined result set.

In response to Applicant's argument that “Nishioka does not disclose the step of finding out a relevance of each document derived from the second document database by calculating an overall weight on both the weighted term list made from the documents inputted to the first document database (i.e., the results of the first search) and the calculated second weights of the terms of documents derived from the second document database (i.e., by the second search) with respect to terms common to both” is respectfully noted but not deemed to be persuasive.

Just as mentioned under the remarks and the 112, second rejection above, the claims appear to be contradict the language of the specification (See published version paragraphs 0033-0035) in regards to the calculation and assignment of relevance weight of the documents whereby the specification only discloses the first search generating the summary weight that is a combination of two different measures within a single database (See published version paragraph

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0018, and paragraph 0025) in contrast to what is being claimed and argued that the calculation of weight is a combination of both first and second searches preformed on two databases. This issue was discussed during the in-person interview on July 31, 2008 and it was agreed that further distinction was needed in the claims.

Applicant's argument that "Barr does not perform a second search of the second database instead the second database is only retrieval of document already searched" is not found to be persuasive.

Barr in column 20, lines 41-55 teaches

(i) sends queries received from the user station 102 to a query engine interface 134, (ii) retrieves a search results list (described above) from the query engine interface 134, (iii) retrieves bibliographical information corresponding to the documents identified in the search results list from database 118a and transmits such information to user station 102, (iv) retrieves text and multi-media files identified by user station 102 from database 118b using document retrieval system 136 and transmits such files to user station 102, (v) transmits information representing each document retrieved from database 118b and user identification information corresponding to the user station 102.

which is just asserted by the Applicant covers the search and retrieval of two separate sets of information from two separate databases (i.e. two searches). The term "retrieval" as it is used in the database art is defined as: Procedure for searching for and extracting database records or content (See google.com). It is unclear how retrieval from a database read in view of Applicant's specification is any different from the claimed "second search". There is no novelty or detailed claimed to the second search to be anything more than what is generally known in the art including operations such as retrieval.

Conclusion

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10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neveen Abel-Jalil
Primary Examiner
September 19, 2008
/Neveen Abel-Jalil/

Examiner, Art Unit 2165